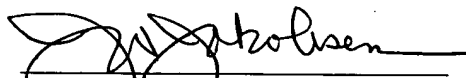


CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231 on the date indicated below.

Date: October 31, 2002


James W. Jakobsen, Reg. No. 38,505

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Denis KHOO, et al.

Serial No.: 09/750,530

Filed: December 28, 2000

Examiner: (To Be Assigned)

Group Art Unit: 2152

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For: **METHOD AND SYSTEM FOR PROVIDING A REWARD FOR
PLAYING CONTENT RECEIVED OVER A DATA NETWORK**

Commissioner of Patents
Washington, D.C. 20231

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. § 1.102(d)

Dear Sir/Madam:

Applicants hereby petition pursuant to M.P.E.P. § 708.02(VIII) to make the above-identified patent application special. If it is determined that the pending claims are not directed to a single invention, Applicants will make an election without traverse as required under M.P.E.P. § 708.02(VIII)(B). The petition fee as set forth in 37 C.F.R. § 1.17(h) is filed herewith. The Commissioner is authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 03-3975. A copy of this petition is included for this purpose.

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I. CITATION OF REFERENCES

Applicants submit that a pre-examination search for prior art deemed most closely related to the subject matter encompassed by the pending claims was made by a professional searcher in the following classes/subclasses:

Class 725, subclasses 5, 8, 9, 32, 34, and 35.

A list of patents found during the pre-examination search and those filed in an Information Disclosure Statement filed on April 27, 2001 is provided herein below.

<u>U.S. PATENT/APPLICATION NO.</u>	<u>INVENTOR(S)</u>
5,508,731 ²	Kohorn
5,604,542 ¹	Dedrick
6,057,872 ¹	Candelore

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¹ Patent found during the pre-examination search.

² patent filed in an Information Disclosure Statement filed on April 27, 2001.

Enclosed herewith are an Information Disclosure Statement including Form PTO-1449 for the patents found during the pre-examination search and a copy of each reference cited in the Form PTO-1449.

II. DETAILED DISCUSSION OF THE CITED REFERENCES**U.S. Patent No. 5,508,731 to Kohorn**

Kohorn discloses a system and method for generating an enlarged participatory broadcast audience. More particularly, a system and method is disclosed for wagering and for evaluating responses to broadcast programs (e.g., television programs) that include an instructional signal modulated onto a signal transmitted concurrently with the broadcast program, or time-multiplexed with a television. At each of a plurality of remote receiving stations, one or more members of a remote audience has the opportunity to respond to a situation presented on the broadcast program by entering a response on a keyboard. At each remote receiving station there

is: (a) a response unit having a memory responsive to the instructional signal for storing acceptable responses; (b) a comparison circuit for comparing responses entered at the keyboard with those stored in the memory; (c) circuitry for scoring responses in accordance with commands from the instructional signal; and (d) a recording device for providing a permanent record of the audience score at the remote station. For conducting a sweepstakes, numbers of other responses are entered at the remote stations and are stored at a central facility for verification. Evaluation of a response may be performed at a central location or by a player's response unit. The program may be presented live conducted by a host at a central station, or by a prerecorded message accessible by telephone from a remote station with regulation from a central station, and may be transmitted via satellite simultaneously to numerous central stations for rebroadcast to an enlarged participatory audience.

U.S. Patent No. 5,604,542 to Dedrick

Dedrick discloses a system and method for transmitting an electronic advertisement within the vertical blanking interval of a video signal. The system includes an encoder that formats and inserts an electronic advertisement into the vertical blanking interval of the video signal, a transmitter that transmits the video signal and the electronic advertisement, a receiver that receives the video signal and the electronic advertisement, and a decoder which removes the electronic advertisement from the video signal. The advertiser may accredit an account of the end user upon receipt of the returned advertisement to provide an inducement to read the ad.

U.S. Patent No. 6,057,872 to Candelore

Candelore discloses a system in which digital coupons are selectively transmitted in a communication network to subscriber terminals for promotional purposes. Subscribers automatically receive coupon credits when they meet the preconditions of the digital coupons. Free or reduced price pay-per-view programming in particular may be provided when a subscriber purchases a given number of pay-per-view programs at a regular price. The terminals maintain a running balance of available coupon credits and inform the subscriber via a user interface of the available balance. Subscribers can be rewarded for viewing commercial messages by awarding coupons which can be immediately redeemed for pay-per-view programs.

With an optional report-back capability, terminal usage pattern data can be retrieved and analyzed by program service providers to determine the effectiveness of the promotions and to gather additional demographic and individual data.

III. DISCLOSURE IN THE KHOO APPLICATION

The Khoo application discloses a method and system for providing a reward for displaying motion picture or audio content over a data network. The content is sent from a server over a data network to a content display (for video) or playback (for audio) device. Information identifying a viewer/listener of the content is preferably stored within the device. The content is played back on the display/playback device for a display/transmission period. The display/transmission period is generally a predetermined amount of time, which is monitored by the content display/playback device. A processor within or coupled to the content display/playback device monitors whether the content is displayed/played for the display/transmission period using, for example, an internal software clocking device. Display/transmission verification data is then sent over the data network to a reward engine in the server to verify that the motion picture or audio content was played back for the display/transmission period. A reward is then provided to the viewer or listener. A reward may include the viewer/listener being entered into a sweepstakes, receiving a monetary reward, receiving a product found in the content.

Generally, the system includes a server in communication with a client via a data network. The server includes a content providing server and a reward engine. The data network is any network with sufficient bandwidth to transmit video/audio signals to a display/playback device. Exemplary clients include a content display/playback device which can be monitored by a viewer/listener such as a conventional television, digital television, high-definition television (HDTV), a computer monitor coupled to a computer system, portable phone, cellular phone, personal digital assistant (PDA), and other portable audio devices such as digital audio players (e.g., MP3 player).

The server includes a content storage device, information database, and reward database. The content storage device is in communication with a content providing server, the information

database is in communication with the content providing server and a reward engine, and the reward database is in communication with the reward engine. The content providing server and reward engine are in communication with the data network, which is in turn in communication with client devices.

The content storage device is capable of storing video and audio content such as television advertisements, audio advertisements, and other video and audio programs in suitable formats. The information database serves as a repository for storing pertinent data regarding viewers and listeners served by the system, for example, viewing/listening habit information and demographic information. The reward database generally stores information describing rewards, information concerning the advertisers sponsoring the rewards, and availability of the rewards. The content providing server interacts with the information database to generate a personalized schedule of programs for particular viewers/listeners served by the system. Personalized information for viewers/listeners who receive rewards is passed from the content providing server to the reward engine so the reward engine can track which viewers/listeners receive rewards. The reward engine can then generate reports identifying the winning viewers/listeners, the rewards received, and other logistic information.

An embodiment of the invention permits viewers/listeners to transmit a message from the content display/playback device via data network to a content providing server to request the delivery of motion picture/audio content from the content providing server. The message includes identification information that identifies the particular viewer/listener associated with the content display/playback device. Use of the identification information is particularly beneficial where personalized schedules of content are maintained by a content providing server for viewers/listeners, so programs and commercials in the personalized schedule can be delivered to the viewer. In response to the message, the content providing server retrieves the content and passes it through the data network to the content display/playback device.

IV. CLAIMS IN THE KHOO APPLICATION

An aspect of the invention disclosed in the Khoo application concerns providing a reward for playing motion picture content received over a data network. Independent Claims 1, 44, 59,

and 61 of the application cover various forms (e.g., system, computer readable medium, electronic signal) of this aspect of the invention. Dependent Claims 2 – 24 and 45 – 51 depend directly or indirectly from Claims 1 and 44, respectively, and cover further details of this aspect of the invention. Representative of this aspect of the invention is method Claim 1, which includes the steps of providing motion picture content; providing a reward engine; transmitting the motion picture content over the data network to a content display device, the content display device having information for identifying a viewer of the motion picture content; displaying, by the content display device, the motion picture content for a display period; transmitting over the data network, to the reward engine, display verification data verifying that the motion picture content has been displayed by the content display device for the display period; and providing the reward to the viewer for displaying the motion picture content.

Another aspect of the invention disclosed in the Khoo application concerns providing a reward for playing audio content received over a data network. Independent Claims 25, 52, 60, and 62 of the application cover various forms (e.g., , system, computer readable medium, electronic signal) of this aspect of the invention. Dependent Claims 26 – 43 and 53 – 58 depend directly or indirectly from Claims 26, 39, and 52, respectively, and cover further details of this aspect of the invention. Representative of this aspect of the invention is method Claim 25, which includes the steps of providing audio content; providing a reward engine; transmitting the audio content to a content playback device over the data network, the content playback device having information for identifying a listener of the audio content; transmitting, by the content playback device, the audio content for a transmission period; transmitting to the reward engine over the data network, a transmission verification data verifying that the audio content has been transmitted by the content playback device for the transmission period; and providing the reward to the listener for transmitting the audio content.

V. DISTINCTIONS BETWEEN THE CLAIMS IN THE KHOO APPLICATION AND THE CITED REFERENCES

Kohorn, Dedrick, and Candelore fail to disclose the use of a content display device having information for identifying a viewer and displaying content to a viewer for a predetermined display period as claimed in independent Claims 1, 44, 59, and 61, and claims that

depend therefrom. The independent claims provide for a method including the steps of providing motion picture content; providing a reward engine; transmitting the motion picture content over the data network to a content display device, the content display device having information for identifying a viewer of the motion picture content; displaying, by the content display device, the motion picture content for a display period; transmitting over the data network, to the reward engine, display verification data verifying that the motion picture content has been displayed by the content display device for the display period; and providing the reward to the viewer for displaying the motion picture content.

Kohorn, Dedrick, and Candelore also fail to disclose the use of a content playback device having information for identifying a listener and transmitting content for a predetermined transmission period as claimed in independent Claims 25, 52, 60, and 62, and claims that depend therefrom. The independent claims provide for a method including the steps of providing audio content; providing a reward engine; transmitting the audio content to a content playback device over the data network, the content playback device having information for identifying a listener of the audio content; transmitting, by the content playback device, the audio content for a transmission period; transmitting to the reward engine over the data network, a transmission verification data verifying that the audio content has been transmitted by the content playback device for the transmission period; and providing the reward to the listener for transmitting the audio content.

Therefore, the Khoo application claims subject matter which is not disclosed, taught or suggested by the foregoing references and is patentable in light thereof.

VI. CONCLUSION

It is respectfully submitted that this Petition, in conjunction with the attachments and enclosures identified above, are sufficient to comply with the requirements of 37 C.F.R. § 1.102(d) and, more specifically, with the provisions set forth in M.P.E.P. § 708.02(VIII).

Accordingly, Applicants respectfully request that this Petition be granted and that the above-referenced application be advanced out of turn for examination. Applicants further request an early and favorable action on the merits.

Respectfully submitted,
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